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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/834,059	04/12/2001	Yong Lung Wei	514-039-11	5262

4955 7590 03/16/2004

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EXAMINER

FOSTER, JIMMY G

ART UNIT	PAPER NUMBER
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3728

18

DATE MAILED: 03/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/834,059

Applicant(s)

WEI, YONG LUNG

Examiner

Jimmy G Foster

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-8 and 17-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-8 and 17-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1) Applicant is advised that amendments filed under 37 CFR 1.173 should only include claims currently being amended or claims being newly added.

However, Applicant's amendment (filed January 22, 2004) has been entered in its entirety.

2) To date, claims 2 and 9-16 have been canceled, and claims 1, 3-8 and 17-25 are pending.

3) The original patent has not been surrendered. Applicant is reminded that this reissue application will not be allowed until the original patent (or affidavit of loss thereof) is actually surrendered.

4) Claims 1, 3-8 and 17-25 are finally rejected as being based upon a defective reissue declaration under 35 U.S.C. 251. See 37 CFR 1.175. This reissue has corrected errors which were not addressed in the original declaration.

Receipt of an appropriate supplemental oath/declaration under 37 CFR 1.175(b)(1) will overcome this rejection under 35 U.S.C. 251. An example of acceptable language to be used in the supplemental oath/declaration is as follows:

"Every error in the patent which was corrected in the present reissue application, and is not covered by a prior oath/declaration submitted in this application, arose without any deceptive intention on the part of the applicant."

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In accordance with 37 CFR 1.175(b)(1), a supplemental reissue oath/declaration under 37 CFR 1.175(b)(1) must be received before this reissue application can be allowed.

5) The affidavit of Kailash C. Vasudeva filed on January 20, 2004 has been considered by the examiner. It is acknowledged that the affidavit states that the subject matter of each of U.S. Patent Nos. 5,803,254, 5,887,715, 6,105,767 and 6,105,770 was under obligation to be assigned to Maxtech from the time the subject matter was developed until formal assignment to Maxtech and was owned by, or obligated to be assigned to, Maxtech at time of its development and all times thereafter. The statement establishes that the subject matter of each of the patents was owned by, or obligated to be assigned to, Maxtech at the time of the claimed invention.

The affidavit of Yong Lung Wei filed on May 23, 2003 has been considered by the examiner. It is acknowledged by the examiner that the affidavit states that Mr. Wei was under the obligation to assign his rights to Maxtech at the time his invention was made.

Accordingly, with full knowledge of the Applicant, it is established by Applicant from the cumulative statements of said affidavits that the subject matters of patent numbers 5,803,254, 5,887,715, 6,105,767 and 6,105,770 and the instant claimed invention (Pat. No. 5,893,457) were owned by, or obligated for assignment to, Maxtech at the time the invention (in Pat. No. 5,893,457) was made. Accordingly, the references of Vasudeva, as Pat Nos. 5,803,254, 5,887,715, 6,105,767 and 6,105,770, may not preclude patentability of the claimed invention under 35 U.S.C. 103.

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6) Claims 18 and 21 are finally rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. More specifically, the limitation calling for the first side wall to be integral with the back wall (claim 18) is considered to be new matter since the specification does not call for this and since the integral nature is not inherent in the drawings.

In addition, the limitation calling for the separating board to be integral with the back wall (claim 21) is considered to be new matter since the original specification does not call for this and since the integral nature is not inherent in the drawings.

7) Claims 1, 3-8 and 21 are finally rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In lines 10-11 of claim 1, it is unclear which pivotal connection is being referred to by the limitation, "the location of the pivotal connection being closer to the front side than to the rear side of said at least one receiving member." Is it the one introduced on line 7 of the claim or the one introduced on line 8?

In lines 16-17 of claim 1, it is unclear what pivotal connection is being referred to by the limitation, "the location of the pivotal connection being closer to the front side thereof than to the rear side of the actuating

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member." Is it the one introduced in line 12 or the one introduced in line 13?

In addition, it is unclear what is referred to in line 17 of claim 1 by the word "thereof."

In claim 21 there is no antecedent basis for "said base" (see line 2), making it unclear what relationship the base has with respect to the base portion already claimed.

8) The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States

(e) the invention was described in

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9) Claims 1 and 6-8 are rejected under 35 U.S.C. 102(e) as being anticipated by Vasudeva (6,105,770). The amendment to Applicant's claim 1 fails to overcome the subject matter of the Vasudeva reference. The added limitation, regarding the pivotal connection being closer to the front side than to the rear side of the receiving member does not overcome the

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configuration that is shown in Figure 9 of the reference of Vasudeva. Likewise, the added limitation, regarding the pivotal connection being closer to the front side than to the rear side of the actuating member does not overcome the configuration of what is shown in Figure 9.

The apparent *effective filing date* of the Wei patent is the actual filing date: April 10, 1998. An *effective reference date* of the Vasudeva patent is at least November 26, 1997 since the patent is a continuation-in-part of the parent application 08/979,879 which itself includes all of the subject matter claimed. In addition, the patent has domestic priority to the provisional application 60/054,395, giving the patent an effective reference date of August 8, 1997 for some claimed subject matter. Therefore, the patent to Vasudeva constitutes a patent of another which was filed as an application in the United States before the invention by applicant (Mr. Wei) for patent.

The tool box of Vasudeva includes a main box 1 and a lid 2. Receiving members are defined by the pivotable holders 10 and are provided within the interior of said main box. Regarding the limitation calling for an actuating member, one of the receiving members 10 of Vasudeva may be considered to be an actuating member since it is capable of being actuated. The lid 2 constitutes means mounted at 3 to the base portion so as to cover the receiving members when in a closed position and to provide access to the interior of the base portion and the receiving member when in the open position.

The receiving member holding compartment may be considered to define a base portion. Depending on the perspective of the viewer, the compartment

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wall near the lid may be considered to be either a bottom or a top, with the opposite wall of the compartment (intermediate of the box) being considered to be the other of the bottom or top. The compartment side walls 14 (see col. 3, lines 50-52) define the base portion side walls. The wall opposite the opening of the compartment defines a back wall. See the perspective of the view shown, for example, in Figure 6.

The receiving members/actuating members 10 are pivotally attached to the side walls at pivotal connection 16.

The tool box further includes sliding plates at gang bars 18. These are pivotally attached to the receiving actuating member 10 at pivotal connection 20. The gang bars may be considered to be sliding plates since the term "sliding" is broad enough to not only define movement with contact, but also gliding/non-contact movement. The reference further discloses plural gang bars/sliding plates, wherein a gang bar/sliding plate will be provided on each side of the holders (col. 3, lines 63-67).

In one embodiment, the gang bars/sliding plates may be pivotally attached to the ends of the receiving members at a location that is rearward of the pivot connection between the receiving members and the wall, as indicated in Figures 9 and 10 of the reference. Thus, the sliding plates may be connected at a rear side of the end of the receiving member. In addition, the connection 16 between the receiving (or actuating) member and the wall may be considered to be at a front side of the receiving member in the Figure 9 configuration. In Figure 9, the receiving members/actuating members are shown in a tilted orientation such that front-most side is the corner extending out of the container opening. The rear-most side of the receiving

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member/ actuating member will be the opposite corner. Accordingly, the pivot connection is closer to the front side than to the rear side in the configuration shown in Figure 9.

Regarding claim 6, which calls for the walls to include apertures and the ends of the receiving members to include stubs, Figure 2 of Vasudeva shows such structure.

10) Claims 17-20 and 22-24 would be allowable if an appropriate supplemental reissue declaration is filed so as to overcome the rejection under 35 U.S.C. 251 set forth in this Office action

11) Claims 3-5 would be allowable 1) if an appropriate supplemental reissue declaration is filed so as to overcome the rejection under 35 U.S.C. 251 set forth in this Office action, 2) if claims are amended to overcome the rejection under 35 U.S.C. 112, and 3) if the claims are amended to include all of the limitations of the base claim and any intervening claims, so as not to depend from a rejected claim.

12) Applicant's arguments filed September 4, 2003 regarding claims 1, 6-8, 18 and 21 have been fully considered but they are not deemed to be persuasive. Regarding the rejection of claims 18 and 21 under 35 U.S.C. 112, first paragraph, with respect to new matter, the examiner does not agree that the Figure 2 of Applicant inherently shows the side wall and the separating board as being integral with the back wall. All that Figure 2 appears to inherently show is that the side wall and the separating board are adjacent to the back wall.

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The rejection to claim 21 under 35 U.S.C. 112, second paragraph is not overcome since "said base" in line 2 of the claim was not changed.

The anticipatory rejection of claims 1 and 6-8 is not overcome by Applicant's amendments calling for the pivotal connection to be located closer to the front side than the rear side, for each of the receiving and actuating members, since these changes do not overcome what is shown in Figure 9 of Vasudeva.

13) **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

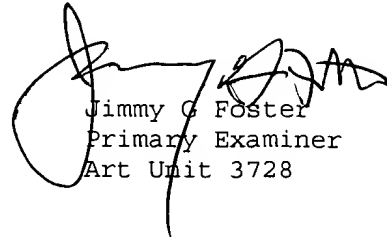
A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

14) Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jimmy G Foster whose telephone number is (703) 308-1505. The examiner can normally be reached on Mon-Fri, 8:45 am - 5:15 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (703) 308-2672. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.



Jimmy G. Foster
Primary Examiner
Art Unit 3728

JGF
10 March 2004